

REMARKS**INTRODUCTION**

In accordance with the following, reconsideration of the allowability of all claims is respectfully requested. No new matter is being presented, and approval and entry are respectfully requested.

Claims 3-7 and 9-34 have been allowed, and claims 1, 2 and 8 stand rejected.

Claims 1-34 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 103:

Claims 1 and 2 stand rejected under 35 USC § 103(a) as being obvious over Yamashina, JP10-138667, in view of Moreno, U.S. Patent No. 4,007,355. This rejection is respectfully traversed.

By way of review and as an example, independent claim 1 sets forth:

"[a] trading card communicating with recording and/or reproducing units to receive messages from a subject printed on the trading card, the trading card comprising:

a data storage unit storing subject-related data of the subject printed on the trading card, wherein the data storage unit reproduces and transmits the subject-related data to the recording and/or reproducing units in the form of an optical or radio signal to simultaneously reproduce the subject-related data of the subject printed on the trading card in the recording and/or reproducing units, wherein the data storage unit receives a recording command from the recording and/or reproducing units to record the subject-related data stored in the recording and/or reproducing units from the subject."

The Office Action has indicated both that it would have been obvious to combine Yamashina and Moreno and that the combination of the same would disclose the presently claimed invention. Applicant respectfully disagrees.

Yamashina would appear to merely be a trading card matched with a CD-ROM, or related disc type recording device. In FIGS. 1, 7, 9, 10 and 11, for example, Yamashina illustrates this matching back-to-back of the trading card and the CD. FIGS. 1 and 9 illustrate the trading card having a similar width as the diameter of the CD (encapsulating the CD), while FIGS. 5, 7 and 10 illustrate the trading card having a width smaller than the diameter of the CD (encapsulated by the CD). Regardless, in both examples the system of Yamashina is merely the

matching, back-to-back, of the CD to a trading card.

FIG. 8, of Yamashina, further illustrates that to read information from the CD of the trading card/CD combination must be placed in a reader 7, with that read information being played on the monitor 8.

The Office Action would appear to also mistakenly have referred to this FIG. 8, when the Office Action indicates that Yamashina, in paragraph [0056], "teaches the data storage unit receives a command from the recording and/or reproducing apparatus to reproduce/display image information (see paragraph 56)." Paragraph [0056] of Yamashina refers to FIG. 8, and the communication between read-out equipment 7, monitor 8, and mouse 9, and the controlling of read-out equipment 7 to start reading information from the CD of Yamashina and forward image information to monitor 8. Thus, in Yamashina, the interpreted corresponding "data storage unit" does not receive any commands from a recording and/or reproducing apparatus. There is no disclosed or suggested device in the trading card/CD combination of Yamashina that would enable the same to perform such reception of commands or reproduction of information stored on the CD. Therefore, the proffered combination of references at least fails to disclose this claimed feature.

Thus, Yamashina would appear to merely illustrate a trading card matched with a CD, with the reproduction of information from the CD being implemented according to conventional methods.

As noted above, the Office Action has indicated that it would have been obvious to modify Yamashina to include recording and/or reproducing units recording subject-related data stored in the recording and/or reproducing units onto the trading card/CD of Yamashina.

To disclose this feature, the Office Action relies on Moreno, which would appear to only disclose a smart card with a memory for cash transactions.

The Office Action sets forth that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the recording/writing functionality into the smart card/reader system in order to provide up-to-data to the trading/payment card."

Thus, the Office Action is setting forth the rationale that it would have been obvious to incorporate the claimed data storage unit command receipt to "record the subject related data stored in the recording and/or reproducing units from the subject," "in order to provide up-to-data to the trading/payment card."

However, this rationale would appear to be improper, i.e., the recited motivation to add the claimed element is for Yamashina to include the claimed element. The Office Action sets

forth features disclosed by Moreno and then concludes the same would be modifiable into Yamashina since Yamashina would then have those features. It is respectfully submitted that this is not proper motivation.

There must be something in the record, outside of the present application, that indicates that it would have been beneficial, needed, or desired to incorporate this feature into Yamashina. The record is silent as to why Yamashina would need or desire such a claimed feature of recording to the data storage unit. Rather, it is respectfully submitted that recited motivation is only based on the Examiner's opinion and/or conclusions, and not evidence in the record.

Further, the Office Action relies on Yamashina to disclose the claimed data storage unit receiving a recording command to incorporate the recording feature of Moreno. However, as the data storage unit of Yamashina does not include this command receipt feature, then the addition of the corresponding feature from Moreno similarly wouldn't be applicable.

Lastly, it is respectfully submitted that the proffered combination would not have been obvious without the knowledge and disclosure presented in the present application. Yamashina discloses only a CD mated with a trading card. Moreno sets forth a smart card for cash transactions. The implementation of the cash card smart card in the trading card of Yamashina can only be derived from the disclosure of the present invention. Without the combination of such divergent features in the present invention there would not have been any base for the combination of such divergent references.

Accordingly, it is respectfully submitted that it would not have been obvious to modify Yamashina, in view of Moreno, to disclose the presently claimed invention. In addition, as noted above, it is respectfully submitted that, even as combined, the proffered combination fails to disclose the presently claimed invention.

Therefore, for at least the above, reconsideration of the allowability of claims 1 and 2 is respectfully requested.

Claim 8 stands rejected under 35 USC § 103(a) as being obvious over Yamashina, in view of Raasch et al., U.S. Patent No. 5,956,877. This rejection is respectfully traversed.

By way of review and as an example, independent claim 8 sets forth:

"[a] system, comprising:

a magazine loading trading cards, processing subject-related data stored in the trading cards, and transmitting the subject-related data, wherein the subject-related data comprises moving pictures arranged in a sequence using serial numbers; and

a recording and/or reproducing apparatus receiving the subject-related data and processing the serial numbers to sequentially reproduce the moving pictures via a display unit."

Similar to above, the Office Action indicates that Yamashina discloses a majority of the claimed features. The Office Action sets forth that Yamashina discloses, in paragraphs 50-57, a system "transmitting subject related data" stored on a trading card, wherein the subject-related data comprises moving pictures; and a recording and/or reproducing apparatus receiving the subject-related data and processing to produce the moving pictures via a display unit."

As noted above, it is respectfully submitted the paragraphs [0050]-[0056] have been misunderstood. Yamashina only illustrates a read-out device 7 for reading information from the CD of the trading card/CD, with the read-out device 7 then processing the read information for display on monitor 8.

However, independent claim 8 particularly sets forth: (a) "a magazine loading trading cards, processing subject-related data stored in the trading cards, and transmitting the subject-related data..."; and (b) "a recording and/or reproducing apparatus receiving the subject-related data .. [to] reproduce the moving pictures via a display unit."

The CD of the Yamashina trading card does not process subject-related data stored on the trading card or transmit the subject-related data, as claimed. Yamashina only discloses a CD of the trading card (a) being readable by a read-out device 7 (b).

In addition, similar to above, the Office Action has concluded that the sequential arrangement of moving pictures in the trading cards and the sequential reproduction of the same would have been obvious merely based on the disclosure of Raasch et al. implementing a sequential feature. The motivational rationale for the combination of Raasch et al. and Yamashina is based solely on Raash et al. disclosing a feature and the Examiner's opinion that such an addition to Yamashina would have been obvious because the combination would then have that feature. There must be something in the record providing a need or desire in Yamashina for such a modification. The fact that Raasch et al. derives benefits from the same does not make the addition of that feature obvious in Yamashina.

Accordingly, it is respectfully submitted that it would not have been obvious to combine Yamashina with Raasch et al. to disclose the presently claimed invention. In addition, as noted above, it is respectfully submitted that the proffered combination also fails to disclose the presently claimed invention.

Therefore, reconsideration of the allowability of claim 8 is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

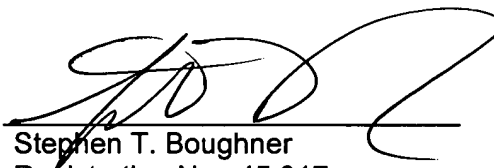
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 10/20/04

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